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10/628,576

07/29/2003

Robert Petit

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SUITE 105  
ALEXANDRIA, VA 22314

EXAMINER

SMALLEY, JAMES N

ART UNIT

PAPER NUMBER

3781

MAIL DATE

DELIVERY MODE

05/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/628,576

Applicant(s)

PETIT, ROBERT

Examiner

James N. Smalley

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-21 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

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### **DETAILED ACTION**

#### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 410. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 1 recites the limitation "portions of the hinge" and "the said mesh" in the first paragraph. There is insufficient antecedent basis for this limitation in the claim. Examiner notes "portions of the hinge" should be changed to "hinge portions" for consistent lexicon within the claim.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1-5 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benedetti US 6,155,443 in view of Yuhara et al. US 4,834,122.

Benedetti '443 teaches a container base (2) and cover (3), connected by a hinge (4), teaching in column 4, lines 6-10 that the friction in the hinge increases as the lid opens.

The reference fails to teach a pushbutton on the side, instead disclosing catch element (22).

Yuhara '122, in the embodiment of figures 13-14, teaches it is known to provide a catch element (100) either at the front end of a base/lid combination device, or to relocate it along the side. This would be desirable to the container of Benedetti '433, to remove it from underneath the handle and make the button more accessible during an emergency.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the container of Benedetti '443, providing a push-button catch on the side of the container as taught to be known by Yuhara '122, motivated by the benefit of relocating the opening actuator from underneath the handle and making the button more accessible during an emergency. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claim 18, Yuhara '122 teaches it is known to form hinged cases in a rectangular shape.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the case of Benedetti '443, forming it into a rectangular shape as taught to be known by Yuhara '122, motivated by the benefit of making the container easier to stack in groups. Furthermore, a change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

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7. Claims 6-11 and 13-14 and 20-21 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Benedetti US 6,155,443 in view of Ojima US 5,142,738 as applied above to claims 1-5 and further in view of Ojima US 5,142,738.

Benedetti '443 fails to teach annular tubular elements.

Ojima '738 teaches a hinge arrangement whereby a coil spring is provided to bias a lid, and where by rings (7) are provided around a pivotable central pin (3) to provide a damped biasing hinge element for a controlled opening. The hinge uses a viscous grease which can be varied in density in order to provide the desired opening/restraining force.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hinge of Bendetti '443, providing the hinge of Ojima '738 motivated by the benefit of providing a mechanically expedient restrained opening mechanism whereby the opening/restraining force can be closely controlled.

Regarding claims 13-14, Examiner reads the tube (3) and shell (2) of Ojima '738 as the male/female parts, respectively.

Regarding claims 20-21, because the combined prior art teaches the claimed structure, the method would have been obvious to one of ordinary skill in the art. Furthermore, Examiner notes the claims are drawn to process limitations within the scope of an apparatus claim. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

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8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benedetti US 6,155,443 in view of Ojima US 5,142,738 and in view of Ojima US 5,142,738, as applied above to claim 14, and further in view of Yuhara US 5,992,426.

Benedetti '443, as modified above, fails to teach the male and female parts being grooved, or the numbers of grooves sufficient for their engagement.

Yuhara '426 teaches it is known to provide interengaging male and female parts for the hinge of a case, whereby each part has knurled surfaces (50) to form a knurled joint (52).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the male and female hinge elements of Benedetti '443, providing the knurled connection (52) taught by Yuhara '426, motivated by the benefit of incorporating the known structure of Ojima '738 into a case hinge with secure engagement. Furthermore it would have been obvious to one of ordinary skill to provide between 3 and 18, or any other suitable number or range of teeth, in order to provide an optimal connection between the parts. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

#### ***Allowable Subject Matter***

9. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:  
See attached PTO-892 citing relevant references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jns



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